

REMARKS

This Amendment is submitted in full response to the outstanding Office Action of December 3, 2003, on the merits of the above-referenced application, and a request for an appropriate extension of time is enclosed herewith along with the corresponding PTO fee. In addition, a "Revocation of Power of Attorney" and a new "Power of Attorney" in favor of the undersigned with respect to the present application, including the required Statement Under 37 C.F.R. 373(b), are being filed concurrently with this Amendment, and copies are attached hereto for your convenient reference. Accordingly, re-consideration of this application is hereby respectfully requested.

In the outstanding Office Action, all of the claims stand rejected. Specifically, claims 1-23 and 25-51 stand rejected under 35 U.S.C. §102(e) as being anticipated by Frailong et al., U.S. Patent No. 6,230,194 (the '194 patent), and claim 24 stands rejected as being unpatentable over Frailong in view of Walker et al., U.S. Patent No. 6,110,041 (the '041 patent). Less significantly, the Examiner has set forth an objection to the specification due to a typographical error.

Applicant is highly appreciative of the Examiner's detailed and conscientious review of this application, and respectfully asks for her reconsideration of same, including the amended and new claims presented herein, in light of the following remarks.

As an initial matter, the Applicant has amended the specification to correct the typographical error, in accordance

with the Examiner's recommendation.

A. Issues Raised by Section 102 and Section 103 Rejections.

Next, and before reviewing the substantive issues with regard to the rejection of the claims, the Applicant respectfully points out the well established requirement that:

For a prior art reference to anticipate in terms of 35 U.S.C. §102, **every** element of the claimed invention must be **identically** shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added).

Moreover, this burden on the U.S. Patent and Trademark Office ("PTO") is further compounded by the fact that the Federal Circuit has stated that within the single reference:

The **identical** invention must be shown in as **complete detail** as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

And, more recently, the Federal Circuit has further expanded this principle to include that:

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed element is not present or is not identically disclosed in as complete detail in a prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 of each claim comprising that element have been overcome. Furthermore,

once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO can not merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the decisions of the Federal Circuit instruct that:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art [and further that] the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Recently, this point was further emphasized by the Federal Circuit, which added that:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness.** In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718, 63 USPQ2d 1031, 1037 (Fed. Cir. 2002); citing In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (emphasis added).

In the outstanding Office Action, the Examiner stated that independent claim 1 of the '194 patent suggests a system comprising, in part, a "remote email server" configured to "receive" the encrypted file from the administration machine and

"store" the encrypted file.

The Applicant, however, respectfully disagrees with the Examiner's interpretation that the '194 patent suggests such a "remote email server."

To begin, the specification of the '194 patent, and in particular, column 5, lines 45-51, and the Internet Service Provider or ISP as indicated by reference numeral 204 in Figure 2 of the '194 patent, are cited by the Examiner in support of the rejection of independent claim 1. However, this portion of the specification of the '194 patent only indicates that:

By providing a configuration management function within remote management server 206 which is registered with an ISP 204, it is possible to download configuration and upgrade information and parameters to gateway interface device 208 at the time the gateway interface is first installed between the client network 220 and the telephone client 204. (column 5, lines 45-51).

The Applicant respectfully maintains that the foregoing disclosure does not identify any "remote email server," rather, it merely indicates that the remote management server (206) is "registered with an ISP," which, as is well known, is necessary to obtain access to the internet. Registration with an ISP, however, does not equate to a "remote email server." Even in the event that "registered with an ISP" were so broadly interpreted so as to encompass a "remote email server," there is nothing in the specification which suggests that any portion of the ISP is configured to "receive" an encrypted file, or any other file, for that matter, from the remote management server (i.e. "the administration machine"), and "store" the encrypted

file. In fact, and again looking to the specification of the '194 patent, the Applicant notes that the disclosure is actually directed to the contrary, stating that:

Remote management server 206 interacts with gateway interface device 208 to provide configuration information and upgrade parameters required by the gateway interface device 208. **In this manner, remote management server 206 basically serves as a repository for information required by gateway interface device 208.** Such information may include configuration information related to LAN 210, internet address blocks, internet domain names, and data related to the physical and logical interfaces between the client network 220 and the ISP 204. (column 5, lines 23-32, emphasis added).

Thus, it is clear that the '194 patent encompasses a system wherein a remote management server, which appears to be akin to the administrative machine of the claimed invention, stores the configuration data required to update a gateway device.

In contrast, independent claim 1 of the present application clearly recites "a remote email server configured to receive the encrypted file from the administrative machine and store the encrypted file." The remote email server is significant in that it eliminates the need for direct communication between the administrative machine and a gateway server while providing configuration or other data to the gateway server, thereby eliminating a potential point of access for a security breach.

Therefore, the Applicant respectfully submits that the '194 patent fails to disclose a "remote email server" configured to "receive" the encrypted file from the administration machine or a "remote email server" configured to "store" the encrypted file, identically and in complete detail as recited in

independent claim 1 of the present application.

In addition, and more importantly, the Examiner has indicted that the '194 patent suggests "a gateway server configured to retrieve the encrypted file from the email server."

Once again, however, the Applicant respectfully disagrees with the Examiner's interpretation of the disclosure of the '194 patent.

As noted above, the specification of the '194 patent is directly counter to such an interpretation and clearly states that "[b]y providing a configuration management function within remote management server 206 ... it is possible to download configuration and upgrade information and parameters to gateway interface device 208." (column 5, lines 45-49). Furthermore, the specification of the '194 patent states that:

Gateway interface device 208 contains a configuration manager which stores the **configuration information transmitted from the remote management server 206.** (column 5, lines 33-35, emphasis added).

Thus, the Applicant maintains that the '194 patent is directed to a system in which configuration information is "transmitted" or "pushed" to a gateway device from an administrative device (i.e. the management server), rather than a system comprising a gateway server structured to "retrieve" or "pull" information from a remote email server, as is recited in independent claim 1 of the present application.

Although the '194 patent contains some limited disclosure wherein "the gateway interface device retrieves the upgrade

package from the specified FTP site, step 1016," (column 15, lines 65-66), significant differences remain between this type of system and the invention of the present application in which the "gateway server ... retrieve[s] the encrypted file from the email server," as recited in independent claim 1.

The present application clearly addresses and distinguishes the use of FTP to effect remote configuration, the specification stating that:

Alternatively, methods of allowing pre-configuration scripts to be backed up from one unit and applied to another via means such as file transfer protocol (FTP) are among other methods of remote configuration. These remote management methods have traditionally required each unit to monitor all incoming messages and respond to incoming requests for reconfiguration from an off-site administrative machine. **Such a method requires that each gateway server maintain an open port for incoming requests, thus, rendering each unit vulnerable to an attack by a hacker.**" (specification, page 3, lines 11-17, emphasis added).

This is clearly the type of system to which the '194 patent is directed. Looking once again to the specification of the '194 patent, it states that:

The remote management server sends a notification message to gateway interface device within client networks which are to be upgraded ... The notification message includes four parameters ... the third parameter is address of the FTP site where the upgrade is available." (column 15, lines 24-38, emphasis added).

The foregoing illustrates that the '194 patent contemplates a system wherein an administrative port must remain open on a gateway device in order to receive a "notification message" from the management device, as well as to receive the upgrade information via the FTP site. In each instance, the open

administrative port of the system of the '194 patent provides a potential point of access for a security breach and, as such, renders such systems vulnerable to attack.

This is in direct opposition to the system recited in independent claim 1 of the present application wherein the "gateway server ... retrieve[s] the encrypted file from the email server," thereby eliminating an open administrative port during system configuration and/or upgrade, and thus, eliminating this avenue of attack to the system.

Thus, the Applicant respectfully submits that the '194 patent also fails to disclose "a gateway server configured to retrieve the encrypted file from the email server" identically and in complete detail as recited in independent claim 1 of the present application.

As such, the Applicant maintains that independent claim 1, as originally submitted, is allowable. Therefore, the Applicant respectfully requests reconsideration of the PTO's rejection of independent claim 1.

Further, the Applicant has herein amended each of the other originally presented independent claims, namely, independent claims 2, 31, and 41, to specifically recite a "remote email server," as disclosed in the present application and as discussed above. In addition, the Applicant has amended several dependent claims to assure proper dependency and/or to assure consistent recital of a "remote email server." The Applicant has also canceled several dependent claims, namely, claims 3, 4,

32, and 42, the subject matter of each cancelled dependant claim being essentially incorporated into the corresponding independent claim.

As such, and in view of the above remarks, the Applicant respectfully submits that amended independent claims 2, 31, and 41, and each of the claims remaining in the present application which depend either directly or indirectly therefrom, are also believed to be allowable. Therefore, the Applicant respectfully requests reconsideration of the PTO's rejection of claims 2, 5-31, 33-41, and 43-51, either as originally submitted or as amended herein.

With regard to the Examiner's rejection of claim 24 under 35 U.S.C. §103, the Applicant submits that in view of the foregoing discussion, claim 24 as originally presented is allowable, and as such, the Applicant again respectfully requests reconsideration of the PTO's rejection of claim 24.

B. New Claims 52-54.

The Applicant further submits that new independent claim 52, which recites an embodiment of the present invention specifically comprising a "a remote email server having at least one file" and "at least one initialized device configured to retrieve the file from the remote email server" is believed, for the reasons presented above, to be in condition for immediate allowance. In addition, the Applicant submits that new dependent claims 53 and 54, which depend directly from new

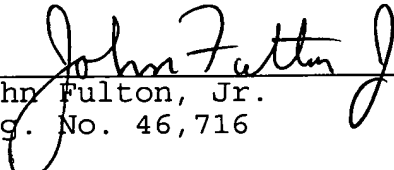
independent claim 52 are, thus, also in condition for immediate allowance. The Applicant submits that new claims 52 through 54 are fully supported by the disclosure of the specification of the present application, and do not contain any new matter.

Accordingly, based on the above Amendments and Remarks, the Examiner is respectfully requested to reconsider her position with regard to the present application. Since nowhere in the art is this new, novel and non-obvious invention found, taught, or suggested, it is urged that this case is now clearly in condition for allowance and, accordingly, such action is respectfully solicited.

In the event that any fee may be required by the filing of this paper, an Authorization to Charge Fees to Deposit Account, **Deposit Account No. 13-1227**, is being filed concurrently with this Amendment.

Respectfully submitted,

MALLOY & MALLOY, P.A.
Attorneys for Applicant
2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129
(305) 858-8000

By: 
John Fulton, Jr.
Reg. No. 46,716

Dated: 5-14-04